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OFFICE OF PETITIONS

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In re Application of	:	
Adam J. Canni et al.	:	
Application No. 10/758,563	:	DECISION ON PETITIONS
Filed: January 15, 2004	:	PURSUANT TO 37 C.F.R.
Attorney Docket No.: IAC 0660 R	:	§§ 1.181, 1.137(A), and
Title: OVERHEAD CONSOLE FOR A	:	1.137(B)
VEHICLE	:	

This is a decision on the petition filed on August 6, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn. Petitioner concurrently submitted two conditional petitions pursuant to 37 C.F.R. §§ 1.137(a)¹ and 1.137(b)² to revive the above-identified application.

1 A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(1);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

2 A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (2) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition

The petition pursuant to 37 C.F.R. § 1.181 is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.137(a) is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.137(b) is **GRANTED**.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. § 1.113 in a timely manner to the final Office action mailed November 4, 2005, which set a shortened statutory period for reply of three months.

A first after-final amendment was received on January 4, 2006, and an advisory action was mailed on January 27, 2006.

A second after-final amendment was received on February 6, 2006, and an advisory action was mailed on March 6, 2006.

A third after-final amendment was received on March 24, 2006, along with a one-month extension of time (a two-month extension of time was required).

No additional extensions of time under the provisions of 37 C.F.R. § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on March 5, 2006. A notice of abandonment was mailed on August 2, 2007, which indicated that the submission of March 24, 2006 failed to constitute a proper reply to the final Office action.

RELEVANT LAW AND PORTIONS OF THE C.F.R. AND MPEP

35 U.S.C. § 133: Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;

- (3) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 C.F.R. § 1.2 sets forth, *in toto*:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

37 C.F.R. § 1.113 sets forth, *in toto*:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 C.F.R. § 1.116 sets forth, *in toto*:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination

proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)

(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission

of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

THE PETITION PURSUANT TO 37 C.F.R. § 1.181

With the present petition, Petitioner has asserted:

the Examiner informed the Applicants on May 1, 2006 (i.e., prior to the date of abandonment) that the application had been allowed and that a Notice of Allowance would be issued shortly...Applicants were also advised on that same date that no additional response to the final Office Action was required.

On May 3, 2006, Petitioner submitted a letter to the Office that set forth, *in toto*:

Based on information provided by Examiner Blankenship to our office on May 1, 2006, we understand that the application has been allowed and that a Notice of Allowance will be issued shortly. Therefore, we understand that no additional response to the final Office Action mailed November 4, 2005 is required.

Petitioner received a final Office action, which rejected claim 69 under 35 U.S.C. § 102. It is clear from rules 37 C.F.R. §§ 1.116 and 1.135 that abandonment of an application is risked when the applicant proffers an amendment after the mailing of a final Office action. The rule clearly indicates that the mere filing of an amendment does not relieve applicant of the duty to take appropriate action to save the application from abandonment.

If steps are not taken after final to maintain pendency prior to the expiration of the maximum extendable period for reply, the application will go abandoned. Put another way, the submission of an after-final amendment which fails to place the application in condition for allowance will result in the abandonment of the application, unless one of the following four items is filed prior to the maximum extendable period for reply:

- a subsequent amendment which places the application in condition for allowance;
- a Notice of Appeal;
- a Request for a Continuation Application pursuant to 37 C.F.R. § 1.53(b), if applicable;
- a Request for Continued Examination pursuant to 37 C.F.R. § 1.114.

(• also a Terminal Disclaimer, if applicable.)

With the present petition, Petitioner has asserted that he did not believe that any action needed to be taken after receiving the third after-final amendment, due to a telephone conversation he purportedly had with the Examiner.

As such, it is clear that that Petitioner relied on this purported oral understanding³. Petitioner was in possession of a Final Rejection that set forth a rejection. The decision maker has reviewed both advisory actions that were mailed in response to the after-final amendments, and neither appears to indicate that the previously made rejection had been overcome by the corresponding after-final amendment. However, Petitioner appears to have discounted the rejection contained in the Final Rejection, based on an alleged oral understanding he had with the Examiner.

Pursuant to 37 C.F.R. § 1.2, Petitioner cannot rely on an oral assurance that was allegedly made by the Examiner, and for this reason, the present petition cannot be granted.

THE PETITION PURSUANT TO 37 C.F.R. § 1.137(A)

The Applicable Standard:

Nonawareness of a PTO rule will not constitute unavoidable delay.⁴

³ It is noted in passing that the submission of the letter of May 3, 2006 does not change the fact that the understanding that Petitioner purportedly had with the Examiner was an oral understanding.

⁴ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

The burden of showing the cause of the delay is on the person seeking to revive the application.⁵

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁶

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁷

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.⁸

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁹

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."¹⁰

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance himself from this attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney."¹¹

⁵ Id.

⁶ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁷ See In re Mattullah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁸ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁹ In re Mattullah, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

¹⁰ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

¹¹ Link at 633-634.

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." ¹²

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." ¹³

Analysis:

The fee that is associated with the filing of the present § 1.137(a) petition has been charged to Petitioner's Deposit Account, as authorized in the petition.

With the present petition, Petitioner has indicated he relied on an oral understanding that he purportedly had with the Examiner. Petitioner cannot act in contravention to a well-established and well-publicized Rule, and later successfully characterize the consequences of his action as "unavoidable."

As such, the present petition cannot be granted.

THE PETITION PURSUANT TO 37 C.F.R. § 1.137(B)

Analysis:

The fee that is associated with the filing of the present § 1.137(b) petition has been charged to Petitioner's Deposit Account, as authorized in the petition.

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. Since the statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

With the present petition, Petitioner has submitted a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114, including a request for consideration of a previously submitted amendment and payment of the RCE fee. The RCE has been accepted

¹² Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

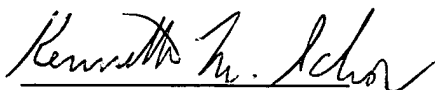
¹³ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

as the required reply under 37 C.F.R. § 1.137(b)(1). Having made a statement which is being construed as the proper statement of unintentional delay and having submitted the petition fee, Petitioner has met all other requirements for a grantable petition under 37 C.F.R. § 1.137(b).

CONCLUSION

Jurisdiction over the present application is forwarded to the Technology Center. The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the submission under 37 C.F.R. § 1.114 - the amendment filed on November 27, 2006 - can be processed.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.¹⁴ All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

¹⁴ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).